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EXAMINER

HO, THOMAS Y

ART UNIT PAPER NUMBER

3677

DATE MAILED: 10/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,558

Applicant(s)

ANDREWS ET AL.

Examiner

Thomas Y Ho

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 3677

DETAILED ACTION

Claim Objections

Claim 18 is objected to because of the following informalities: "mixed" should be corrected to read --fixed--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 7-11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Yu USPN5688063.

As to claim 1, Yu discloses a vibrating body jewelry item to be attached to a body part of a user, comprising: a power source 40; a vibrating motor unit 50; a housing 10/20/101 having a first 10 and second section 20/101 dimensioned and configured to contain said power source 40 and said vibrating motor unit 50 (see Figures 1-2), each said first 10 and second 20/101 sections having mating ends that connect to one another; attachment means (free end of 92) for securing the vibrating body jewelry item to a body part of a user; and a post 92, said housing 10/20/101 being disposed at one end of said post 92, and said attachment means (free end of 92) being disposed at an opposite end of said post 92; wherein said power source 40 and said vibrating motor unit 50 are disposed within said housing 10/20/101.

As to claim 2, Yu discloses said power source is a battery 40.

Art Unit: 3677

As to claim 3, Yu discloses said ends of said first 10 and second 20/101 sections of said housing include thread means for threadingly connecting said sections together.

As to claim 5, Yu discloses said second section 20/101 of said housing includes a recess (chamber in the middle of 101), and said power source is a battery 40, said battery being received on said recess.

As to claim 7, Yu discloses said attachment means (free end of 92; see Figure 1) for securing the vibrating body jewelry item to a body part of a user is a keeper.

As to claim 8, Yu discloses said keeper (free end of 92) is configured to receive an attachment selected from the group consisting of a chain, charm, and other ornamental jewelry piece item. The limitation "configured to receive...piece item" is functional language and holds little patentable weight because the function does not further define the structure. Any structure is somehow configured to receive some kind of attachment.

As to claim 9, Yu discloses said attachment means (free end of 92) for securing the vibrating body jewelry item to a body part of a user is a clamp. The free end of 92 acts as a clamp against the outer wall of cylinder 10.

As to claim 10, Yu discloses said clamping device (free end of 92 against outer wall of 10) includes a movable jaw (free end of 92) and a fixed jaw (outer wall of 10), said movable jaw mating with a stationary jaw to form said clamp device. It is common knowledge that the clip on pens are resilient to a degree.

As to claim 11, Yu discloses a vibrating body jewelry item to be attached to a body part of a user, comprising: a power source 40; a vibrating motor unit 50; a housing 10/20/101 dimensioned and configured to contain said power source 40 and said vibrating motor unit 50;

Art Unit: 3677

attachment means (free end of 92) for securing the vibrating body jewelry item to a body part of a user; a post 92, said housing 10/20/101 being disposed at one end of said post 92, and said attachment means (free end of 92) being disposed at an opposite end of said post 92; wherein said power source 40 and said vibrating motor unit 50 are disposed within said housing 10/20/101.

As to claim 13, Yu discloses said attachment means includes a post 92 inserted through a wearer's pierced body part, and a keeper (free end of 92) to retain said item on the pierced body part. These limitations are intended use and functional and hold little patentable weight. The fact that the attachment means is inserted through a pierced body part or retained on a pierced body part does not further define the structure of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miceli USPN5140840 in view of Gong-Hwa USPN5622062.

As to claim 1, Miceli discloses a body jewelry item to be attached to a body part of a user, comprising: a power source 36/70; an LED unit 58; a housing 28/34 having a first 34 and second 28 section dimensioned and configured to contain said power source 36, each said first 34 and second 28 sections having mating ends that connect to one another; attachment means 16 for securing the body jewelry item to a body part of a user; and a post 82/92, said housing 28/34

Art Unit: 3677

being disposed at one end of said post 82/92, and said attachment means 16 being disposed at an opposite end of said post 82/92; wherein said power source 36 and said LED unit 58 are disposed within said housing 28/34. The difference between the claims and Miceli is the claims recite a vibrating body jewelry item, and a vibrating motor unit. Gong-Hwa discloses a jewelry item similar to that of Miceli. In addition, Gong-Hwa further teaches to include with the LEDs 300 a vibrating motor unit 35 (the buzzer vibrates). It would have been obvious to one of ordinary skill in the art, having the disclosures of Miceli and Gong-Hwa before him at the time the invention was made, to modify the LED of Miceli to include a vibrating motor unit 35, as in Gong-Hwa, to obtain a vibrating body jewelry item having an LED combined with a vibration motor unit. One would have been motivated to make such a combination because the ability to produce both light and sound would have been obtained, as taught by Gong-Hwa (col.1, ln.5-10, ln.35-40).

As to claim 4, Miceli discloses said ends of said first 34 and second 28 sections of said housing have mating snap-fit structures for connecting said sections together (col.2, ln.65-68; col.3, ln.1-5).

As to claim 11, Miceli discloses a body jewelry item to be attached to a body part of a user, comprising: a power source 36/70; an LED unit 58; a housing 28/34 dimensioned and configured to contain said power source 36/70 and said LED unit 58; attachment means 16 for securing the body jewelry item to a body part of a user; a post 82/92, said housing 28/34 being disposed at one end of said post, and said attachment means 16 being disposed at an opposite end of said post 82/92; wherein said power source 36/70 and said LED unit 58 are disposed within said housing 28/34. Gong-Hwa teaches the vibrating motor unit 35 (buzzer) used with an LED unit 300.

Art Unit: 3677

Claims 6 and 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miceli USPN5140840 in view of Gong-Hwa USPN5622062, and further in view of Erickson USPN4781036.

As to claim 6, Miceli discloses said post has an end and said housing 28/34 has a recess defined in the second section 28/86 (recess is defined by where post 82/92 enters the surface of 86), and wherein said post extends through the recess in the second section 28 in order to move said power source 36/70 onto said LED unit 58 thereby activating said LED unit 58. The post 82/92 extends through a recess in the surface 86 of the housing 28; the post 82/92 moves the power source 36/70 onto the LED unit 58 by way of spring 75/76 to activate the LED. The difference between the claims and Miceli is the claims recite said post has a threaded end and a threaded recess, and a vibrating motor unit. Gong-Hwa teaches the vibrating motor unit 35 (buzzer). Erickson discloses a jewelry article similar to that of Miceli. In addition, Erickson further discloses the post 10 having a threaded end to engage a threaded recess in the housing 12/14. It would have been obvious to one of ordinary skill in the art, having the disclosures of Miceli and Erickson before him at the time the invention was made, to modify the post end and recess of Miceli to have complementary threads, as in Erickson, to obtain a post with a threaded end engaging a threaded recess on the housing. One would have been motivated to make such a combination because the ability to remove the end elements and replace them with other ornaments would have been obtained, as taught by Erickson (col.2, ln.1-5).

As to claim 12, Miceli discloses said post 82/92 has an end and said housing 28/34 has a recess (where 92 meets the surface of 86) formed therethrough, and wherein the end extends through the recess in order to selectively engage said LED unit 58 with said power source 36/70.

Art Unit: 3677

The slidable portion 82 of the post 82/92 is mounted to selectively engage the power source 36/70 and LED unit 58 by way of spring 75/76. Gong-Hwa teaches the vibrating motor unit 35. Erickson teaches the threaded end on the post 10 and threaded recess on the housing 12/14.

As to claim 13, Miceli discloses said attachment means includes a post 82/92 inserted through a wearer's pierced body part, and a keeper 16 to retain said item on the pierced body part.

As to claim 14, Miceli discloses said keeper 16 comprises a ring. The keeper 16 is a ring with a display element 20 mounted over one end hole.

As to claim 15, Miceli discloses a body jewelry device for attachment to a body part of a user, comprising: a housing 28/34 having a recess (where 92 enters 86) defined therein; a LED unit 58 disposed in the housing 28/34, the LED unit 58 having a contact node 42 depending therefrom; a battery 36/70 disposed in the housing 28/34; a flexible cushioned barrier 75/76 disposed between the LED unit 58 and the battery 36/70 (see Figure 5; the beginning portion of the flexible barrier 75/76 is clearly between the lower portion 74 of the battery 36/70 and the lower portion of node 42), the barrier 75/76 having a recess defined therein (region within the spring 75/76) aligned with the contact node 42; at least one post 82/92 having a first end and having a second end, the first end being inserted into the recess (where 92 enters 86) defined in the housing 28/34; and attachment means 16 for securing the body jewelry item to a body part of a user; wherein, the post 82/92 is movable between a first position in which the barrier 75/76 separates the battery 36/70 from the contact node 42 in order to prevent the device from activating, and a second position in which the post 82/92 forces the battery 36/70 against the contact node 42 (by way of spring 75/76) in order to activate the LED unit 58. Gong-Hwa

Art Unit: 3677

teaches the vibrating motor unit 35. Erickson teaches the threaded recess on the housing 12/14 and a threaded end on a post 10.

As to claim 16, Miceli discloses said attachment means comprises a keeper 16, the device being adapted for attachment to a pierced body part with the post 82/92 extending through the body part, said housing 28/34 and said keeper 16 being adapted for preventing the post 82/92 from sliding through the body part.

As to claim 17, Miceli discloses said attachment means comprises a keeper 16, the keeper being ring-shaped (16 is a ring with a display item 20 mounted over one end of hole 22), the device being adapted for attachment to a pierced body part with the post 82/92 extending through the body part, said housing 28/34 and said keeper 16 being adapted for preventing the post 82/92 from sliding through the body part, said ring-shaped keeper 16 being adapted for receiving a chain, a charm, and ornamental jewelry items. The limitation "adapted for...items" is functional and holds little patentable weight because it does not further define the structure.

Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miceli USPN5140840 in view of Gong-Hwa USPN5622062, and further in view of Erickson USPN4781036, and further in view of Moody USPN4840045.

As to claim 18, Miceli discloses an attachment means 16. The difference between the claims and Miceli is the claims recite said attachment means comprises a clamp having a fixed jaw and a movable jaw pivotally attached to the fixed jaw, the clamp being adapted for attachment to a body part. Moody discloses a jewelry item similar to that of Miceli. In addition, Moody further teaches a housing 11 with a post 13 having an attachment means on the other end comprising a clamp having a fixed jaw 50/54 (see Figure 4) and a movable jaw 16/18 pivotally

Art Unit: 3677

attached 30/31 to the fixed jaw 50/54, the clamp being adapted for attachment to a body part. It would have been obvious to one of ordinary skill in the art, having the disclosures of Miceli and Moody before him at the time the invention was made, to modify the attachment means 16 of Miceli to have the clamp of Moody, to obtain an attachment means that can clamp to a body part. One would have been motivated to make such a combination because the ability to convert pierced-ear earrings for unpierced ears, and to make earrings into lapel pins would have been obtained, as taught by Moody (col.1, ln.15-21).

As to claim 19 Miceli discloses said at least one post further comprises: a first post 82/92, the attachment means comprising a keeper 16, the device being adapted for attachment to a pierced body part; a second post 82/92, the attachment means comprising a ring 16 (16 is a ring having a display element 20 over one hole) adapted for receiving an ornamental jewelry attachment 20, the device being adapted for attachment to a body part. Moody discloses a third post 13, the attachment means comprising a clamp (see Figure 4) having a fixed jaw 50/54 and a movable jaw 16/18 pivotally attached to the fixed jaw, the device being adapted for attachment to a body part; wherein said first, second and third posts are interchangeably attached to said housing 28/34 in order to attach the device to a body part, whether the body part is pierced or unpierced. This limitation holds little patentable weight because the single jewelry item is never shown with three posts simultaneously. Furthermore, the claiming of interchangeability indicates that this claim is describing three species of the same invention, and none of the disclosed posts is used while another post is present.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miceli USPN5140840 in view of Gong-Hwa USPN5622062, and further in view of Erickson

Art Unit: 3677

USPN4781036, and further in view of Riley USPN5048310, and further in view of cited case law.

As to claim 20, Miceli discloses said housing 28/34 has a first section 34 and a second section 28, the first and second sections having mating male and female snap-fit connectors (col.2, ln.65-68; col.3, ln.1-5). The difference between the claims and Miceli is the claims recite threaded connectors in place of snap-fit. Riley discloses a jewelry item similar to that of Miceli. In addition, Riley further teaches the interchangeability of threaded connectors 2/3 (see Figure 1) and snap-fit connectors 8/9/10/11 (see Figures 3-4). Inasmuch as the references disclose these elements as art recognized equivalents, it would have been obvious to one of ordinary skill in the exercise art to substitute one for the other. In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a snap-fit connection to be a threaded connection, because they are equivalent means of fastening, both old and well known in the art, and both known to be readily interchangeable in the art.

Response to Arguments

Applicant's arguments, see Amendment B and Declaration under 37 C.F.R. 1.131, filed 9/26/03, with respect to the rejection(s) of claim(s) 1-20 under 35 U.S.C. 102(e) and 35 U.S.C. 103(a) with the primary reference of Klein USPN6419649 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made as presented in the detailed action above.

Applicant has removed Klein USPN641649 as a reference by presenting a Declaration under 37 C.F.R. 1.131 that shows applicant's invention pre-dating the effective date of Klein.

Art Unit: 3677

In response to applicant's argument (pg.9) against Miceli, it must be recognized that an alternate interpretation of Miceli reads on the claimed limitations. The element 70 can be considered a part of the battery, and so the spring 75/76 is between the end portion of 70 and the bottom portion of node 42. Further, the spring 76 can be electrically conductive and still read on the claims because non-conductivity is never claimed.

In response to applicant's argument (pg.9) that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Y Ho whose telephone number is (703)305-4556. The examiner can normally be reached on M-F 10:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J Swann can be reached on (703)306-4115. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)306-1113.

Application/Control Number: 09/812,558

Page 12

Art Unit: 3677

TYH


ROBERT J. SANDY
PRIMARY EXAMINER